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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/576,332

04/18/2006

Detlef Biernat

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REED SMITH, LLP

ATTN: PATENT RECORDS DEPARTMENT

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NEW YORK, NY 10022-7650

EXAMINER

STULTZ, JESSICA T

ART UNIT

PAPER NUMBER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/576,332	<b>Applicant(s)</b> BIERNAT ET AL.	
	<b>Examiner</b> Jessica T. Stultz	<b>Art Unit</b> 2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>041806</u>  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 5 and 7 are objected to because of the following informalities: claim 5, line 7, "fundus camera and ophthalmoscope" should be "fundus camera and/or ophthalmoscope"; claim 7, line 3, "to the illumination source for continuous illumination of the sclera" should be "to the illumination source, which provides continuous illumination of the sclera" since there is no previous mention of the illumination source of claim 5 providing continuous illumination; claim 7, line 5, "by optical means" should be "by an optical means" since there is no previous mention of an optical means in claim 5. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 5-6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Pomerantzeff US 4,200,362, herein referred to as Pomerantzeff '362.

Regarding claim 5, Pomerantzeff '362 discloses an illumination unit ("22") for fundus cameras and/or ophthalmoscopes (Abstract and Column 3, lines 35-66, wherein the ophthalmoscope is "10", Figures 1-3) having a front lens (lens "18") for generating a uniform illumination of the fundus by transillumination of the sclera ("12c"), comprising: an illumination source for emitting light (Column 3, lines 35-66, wherein the illumination source is "24", Figures 1-3); the light emitted by the illumination source being coupled into individual light-conducting

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fibers or bundles of light-conducting fibers (bundles "22a" and "22b") which extend into the area of the front lens of the fundus camera and/or ophthalmoscope (Column 3, lines 35-66, Figures 1-3); and ends of said fibers being formed in such a way that the exiting light is projected on the sclera of the eye to be examined and transilluminates the sclera (Column 3, lines 35-66, Shown in Figures 1-3).

Regarding claim 6, Pomerantzeff '362 further discloses that at least one light-conducting fiber or bundle of light-conducting fibers is provided and arranged in such a way that the light of the illumination source transilluminates the sclera in the nasal and temporal area (Column 4, lines 22-41).

Regarding claim 8, Pomerantzeff '362 further discloses that the ends of the light-conducting fibers or light-conducting fiber bundle located in the area of the front lens can be moved separately or jointly independent from the position of the fundus camera (Column 11, lines 1-19, wherein the illumination system "22" comprising bundles "22a" and "22b" operates independently of the photographic exposure device, Figure 10).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pomerantzeff '362, as applied to independent claim 5 above, and further in view of King US 4,575,208, herein referred to as King '208.

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Regarding claim 7, Pomerantzeff '362 disclose an illumination unit as shown above wherein the illumination source provides continuous illumination of the sclera for purpose of observation (Column 11, lines 1-19, wherein the illumination source "24"/"24'" provides continuous illumination to eye "12"/"12'", Figures 1-3 and 10) wherein the light of the continuous illumination source is imaged onto the sclera by an optical means (Shown in figure 10, wherein the illumination source "24'" provides illumination via lenses), but does not specifically disclose that the illumination unit comprises an additional pulsed light source provided for electronic and/or photographic documentation in addition to the illumination source, which provides continuous illumination of the sclera for purposes of observation, wherein the light of the continuous illumination source is imaged in the focal plane of the pulsed light source by an optical means. King '208 teaches of an illumination unit for fundus cameras and/or ophthalmoscopes (Column 1, lines 5-10, wherein a fundus camera is used to photograph the sclera of a patient's eye) having a front lens (lens "2", Figure 2) for generating a uniform illumination of the fundus by transillumination of the sclera (Column 2, lines 28-45) comprising: an illumination source for emitting light (Column 3, lines 25-32, wherein the illumination source is "12", Figures 1-3); the light emitted by the illumination source being coupled into a light-conducting fiber (Column 3, lines 33-66, wherein the source "12" is coupled into tube "20", Figures 1-5) which extends into the area of the front lens of the fundus camera (Column 3, lines 12-66, Figures 1-5); and ends of the fiber being formed in such a way that the exiting light is projected on the sclera of the eye to be examined and transilluminates the sclera (Column 2, lines 28-45) and further teaches that the that the illumination unit comprises an additional pulsed light source provided for electronic and/or photographic documentation (Column 3, line 33-Column 4,

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line 7, wherein the additional pulsed light source is strobe light “16” which provides a pulsed light for photography purposes, Figures 5-8) in addition to the illumination source which provides continuous illumination of the sclera for purposes of observation (Column 3, lines 25-33, wherein the light “12” provides continuous illumination of the sclera for focusing, Figures 5-8), wherein the light of the continuous illumination source is imaged in the focal plane of the pulsed light source by an optical means (Column 4, lines 39-66, wherein the strobe light “16”/”35” travels the same path as the focusing light “12”/”35” via a fiber optic cylinder “4”/”37”, Figures 5-8) for the purpose of providing focusing of the eye to be photographed and to avoid obliteration of a portion of eye due to reflections of light from the fiber optics (Column 4, lines 39-66). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the illumination unit of Pomerantzeff ‘362 to further comprise an additional pulsed light source is provided for electronic and/or photographic documentation in addition to the illumination source, which provides continuous illumination of the sclera for purposes of observation, wherein the light of the continuous illumination source is imaged in the focal plane of the pulsed light source by an optical means since King ‘208 teaches of an illumination unit for fundus cameras and/or ophthalmoscopes having a front lens for generating a uniform illumination of the fundus by transillumination of the sclera comprising: an illumination source for emitting light; the light emitted by the illumination source being coupled into individual light-conducting fibers which extend into the area of the front lens of the fundus camera; and ends of said fibers being formed in such a way that the exiting light is projected on the sclera of the eye to be examined and transilluminates the sclera and further teaches that the illumination unit comprises an additional pulsed light source provided for electronic

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and/or photographic documentation in addition to the illumination source which provides continuous illumination of the sclera for purposes of observation, wherein the light of the continuous illumination source is imaged in the focal plane of the pulsed light source by an optical means for the purpose of providing focusing of the eye to be photographed and to avoid obliteration of a portion of eye due to reflections of light from the fiber optics (Column 4, lines 39-66).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Volk US 5,200,773 and Kohayakawa US 4,257,687 are cited as having some similar structure to the claimed invention since they disclose indirect ophthalmoscopes that illuminate the sclera of a patient's eye.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica T. Stultz whose telephone number is (571) 272-2339.

The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on 571-272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jessica T Stultz  
Primary Examiner  
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